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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,770	04/11/2001	Carlos De La Huerca	250591.90279	2242

7590 03/29/2005

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EXAMINER

MISKA, VIT W

ART UNIT PAPER NUMBER

2841

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,770

Applicant(s)

DE LA HUERGA, CARLOS

Examiner

Vit W. Miska

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-153 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 16, 18-21, 30-32, 34, 35, 37-106 and 109-153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 17, 22-29, 33, 36, 107 and 108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority of S.N. 09/185,137

1. The references to prior application 09/185,132 in the oath and other papers filed appears incorrect. The correct application no. is 09/185,137 (U.S. Patent No. 6,259,654). Correction is required.

2. With respect to the use of the Yarin patent as a reference against some of applicant's claims, applicant notes support for the subject matter of the claims in prior application S.N. 09/185,137, of which this application is a continuation-in-part. Specifically, regarding claim 1, applicant refers to the last paragraph of the detailed description of the patented application for support for "RF memory devices and sensors". Col. 32 lines 24-26 of the patented application suggest: "The memory device or memory strip could also communicate with the processor of the container via RF technology." No further details are set forth in support of this modification.

3. The determination of whether applicant is entitled to the benefit of the filing date of a prior U.S. application is governed by 35 U.S.C. 120:

" An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United

States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application..."

Specifically, the description requirement of the first paragraph of 35 USC 112 must be met in the prior application for any subject matter for which the priority date is sought. "The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed: See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117." (MPEP 2163), or whether the claims contain subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

4. Claim 1 of the present application recites a container having "an RF memory device" and "an RF sensor defining a sensing area, the sensor for receiving the specifying information when the RF memory device is within the sensing area". The prior application does not set forth an RF sensor per se, or an RF sensor "defining a sensing area", or suggest that the sensor receives the specifying information "when the RF memory device is within the sensing area", as claimed. The statement in the patented application that the "memory device or memory strip could also communicate with the processor of the container via RF technology" at best suggests that the memory device and the processor have some type of RF communication means. Although RF devices generally operate within an area of reach of the RF signals, numerous RF communication

devices exist in the prior art, and the prior specification makes no mention of the specific RF sensor "defining a sensing area", as now claimed. Therefore, the subject matter of claim 1 and claims depending therefrom are not entitled to the priority date of application 09/185,137.

5. With respect to claims 22-26, 36, 107 and 108 the subject matter defined by these claims appear to be broadly disclosed in the prior application as noted by applicant.

6. However, claims 27-29 and 33 do not set forth subject matter which was described in the prior application in a manner to convey to one skilled in the art that applicant had possession of the invention at the time of filing thereof. Specifically, the prior specification or drawings lack reference to a "horizontal sensor surface" of the sensor, or to the containers including "at least one essentially downward facing surface, the specifying devices are attached to the downward facing surfaces" of claim 27. The statement appearing in the last paragraph of the prior application suggests that "the container could be a tray or cassette that does not include a cap, cover or lid". While the structure now claimed possibly could be included in the implementation of the suggested modification, the description does not convey the suggestion that applicant in fact contemplated this specific construction. It is apparent that the suggested modification could be realized in other ways, for example with the bar code (specifying device) arranged on the side of the containers or vials. Further, if RFID specifying devices were

used, these do not require a specific location on the containers, as now claimed.

Regarding claim 33, no scanning operation is suggested or implied in the prior disclosure.

Claim Objections

Claims 3-10 are objected to because of the following informalities: Claim 3 recites the limitation "the antenna" in line 2. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-11, 15, 17, 27-29 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Yarin et al. The reference discloses a medication system for performing health safety functions including containers 34 for holding doses of medication, the containers having RF memory device 50 containing specifying information useable to determine a prescribed dosing regimen for the medication (see col. 7, lines 39ff and col. 9, lines 7ff), RF sensors 41 (antennae) defining sensing areas 36 for receiving the specifying information, processor 40 receiving the specifying information to identify a prescribed dosing regimen (col. 9, lines 7-20), communication device 36 or 36' (Fig. 13), timing device inherently associated with processor 40 (see also col. 10, line 60) and necessary to produce the time alerts for the medication, the processor causing the communication means 36 to indicate predetermined times, col. 10, line 66, horizontal sensor surface 30, container 34 with downward surface 34a and RF tag 50 attached thereto, aligners 32 for distinguishing sensing and non-sensing sections.

8. Claims 22 and 107 are rejected under 35 U.S.C. 102(a) as being anticipated by Glynn. The reference discloses a medication system for performing at least one health safety function including containers 1,2,4 having specifying devices 3,5,7, respectively containing specifying information (medicine identity information, col. 4, line 39), sensor 11,13 defining sensor area of tray 9 capable of receiving several specifying devices at the same time and corresponding specifying information, processor 21 receiving the specifying information read by the sensor to identify a prescribed dosing regimen and

performing a health safety function described at col. 5, lines 16ff, i.e. prompting the user to take the medication.

9. Claims 22-26, 107 and 108 are rejected under 35 U.S.C. 102(b) as being anticipated by Mucciacciaro. The latter reference discloses a medication system with containers 4 with specifying devices 15,16 containing specifying information (the shape of the devices identifying the particular container), sensors 6 defining sensing areas 13,14 etc. for identifying the containers, and processor 7 for identifying a dosing regimen and performing a health safety function of prompting the user to take the medication (col. 3, lines 10ff), communication devices including separate visual indicators 12 indicating the medication to be consumed, the processor including timing device 9 to determine when the time for taking each medication occurs (see Fig. 8 and col.3, lines 7-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

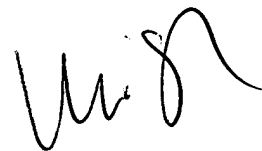
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 23-26 and 108 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn in view of Mucciacciaro. The Glynn reference has been described above and includes the claimed elements except for the communication means indicating the containers. It appears that the user is informed of which medication to take by means of output display 33. It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container, as done in the Mucciacciaro device at 12, as an obvious means for prompting the user to take the medication in the correct container.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, K. Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vit Miska
Primary Examiner

VM
3/16/2005